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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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08/526,091 09/11/95 SHIMIZU

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ART UNIT PAPER NUMBER

2514

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DATE MAILED: 10/01/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 30 August 1996 ("Ault")
- ☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 13-26 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 13-46 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Part III DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 30 August 1996.

Additional Remarks

2. Acknowledgement is made that "it is respectfully requested that the Examiner postpone any necessary changes to the specification until this application is ready for allowance" (see pg. 6, lines 4+, "REMARKS").

3. The application contains disclosure entirely outside the bounds of the allowed claims. Applicants are required to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims (M.P.E.P. § 1302.01).

Furthermore, the Applicants are reminded that figures 1-5, 7-9, 14-16, 18-28, and 31 are extraneous subject matter and therefore it should be modified or deleted. Figures 6, 10-13, 17, 29-30, and 32-33 are most pertinent to the present claimed invention.

Specification

4. Applicants should note that "Page 5, line 24, change "Furthermore" to --Meanwhile--", and "Page 70, line 26, delete "actually"" (see pg. 3, lines 3 and 16 of the Amendment) were not entered because it could not be located. Please clarify and correct in next response.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 22 is rejected under 35 U.S.C. § 102(b) as being anticipated by Collins, Jr. (US 5,149,947, hereinafter Collins).

Collins shows and teaches a portable check-out system having all of the elements and means as recited in claim 22. For example, Collins teaches the following:

A purchased commodity accommodating and transporting apparatus/cart 50 (see figs. 3-5; and col. 3, lines 46-49) comprising scanning terminal 44 (see figs. 3-5; and col. 3, lines 46+); an accommodation section (see figs. 3-5); a magnetic card reading section [88, 90] (see figs. 3-5; and col. 4, lines 3-8); a commodity price retrieval section [102, 104] (see fig. 7; and col. 4, lines 30+); and a management section 110 (see col. 4, lines 37+). Furthermore, Collins clearly shows and discloses that the above elements and the means are **fixed** to the purchased commodity accommodating and transporting apparatus/cart 50 (see fig. 5, and col. 3, lines 46+).

Although, Collins is silent with respect to the "automatic clearing processing section for automatically clearing the amount of money corresponding to the price of the commodity retrieved by said commodity price retrieval section from an account corresponding to the magnetic information of the card read by said magnetic card reading section ...", it is clearly inherent and anticipated by Collins to accomplish the above task/validation of the credit card account upon completion of the purchase.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

5 A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

15 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

20 8. Claims 13-21 and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Collins. The teachings of Collins have been discussed above.

25 Re claims 13-15 and 23: Although, Collins fail to show or disclose a "prepaid card inputting processing section ... reading remains information of the prepaid card" as recited in claims 13 and 23; "a notification section for notifying, when the remains read by said prepaid card ... shortage" as recited in claim 14; and "a selection section for selecting ... inserting a second prepaid card ... purchasing processing is to be ended" as recited in claim 15, it would have been obvious to an artisan at the time the invention was made to substitute the credit card system as taught by Collins with a notoriously old and well known prepaid card system due to the fact that both the credit card and the prepaid card are

art recognized equivalent and/or substitution of equivalents. Furthermore, with respect to the "reading remains ... prepaid card", "notification section ...", and "selection section ... inserting a second prepaid card", one of ordinary skill in the art would have recognized that such practices as discussed above are commonly practiced in the prior art systems (e.g., Metro fare cards are believed to be a prepaid cards whereby the Metro fare card system clearly practices the above practices and/or procedures). Thus, in view of the commonly known practices/procedures, as discussed above, it would have been obvious to an artisan at the time the invention was made to incorporate such conventional practices/procedures to the teachings of Collins because such incorporation would have constituted an obvious expedient well within the ordinary skill in the art.

Re claims 16-18: As to the "receipt issuance section", Collins discloses a printer 84 which issues a receipt 86 (see col. 3, lines 67+; and col. 4, lines 51-52).

Re claims 19-21: With regard to "receipt issuance selection section for selecting whether the issuance of a receipt by said receipt issuance section is necessary or unnecessary", it would have been obvious to an artisan at the time the invention was made to incorporate such receipt issuance selection section to the teachings of Collins due to the fact that it is notoriously old and well known in the prior art systems, such as retail stores, grocery stores, etc., whereby the vendee can specifically request to the vendor to either provide him/her (i.e., the vendee) with a receipt of the purchases made or to discard it. Since, Collins discloses a stand-alone credit card check-out system and the printer for printing the receipt, in view of the conventional procedures as discussed above, one of ordinary skill in the art would have contemplated that one (i.e., the vendee) may or may not wish to receive a receipt

upon completion of the transaction, and therefore, to incorporate the receipt issuance selection section would have constituted an obvious expedient well within the ordinary skill in the art.

9. Claims 24-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Collins, in view of Ehrat (US 3,836,755). The teachings of Collins have been discussed above.

5 Collins fail to show or teach "a data reception section for receiving data from a management section, and a power on/off drive section ..." as recited in claim 24; and "a weighing equipment for measuring the total weight of commodities ... detecting the variation of the total weight of the commodities .. , and alarm generation section ..." as recited in claims 25 and 26.

Ehrat teaches a purchasing trolley 2, comprises a reading means 24; a goods basket 18;
10 weighing pan of scales 182; signaling means [SE₁, SE₂]; a purchasing container electronic system 91 to determine whether the data of the data support were correctly read and whether the weight increase measured by the scales coincides within specific limits with the weight data on the data support or whether placing the article into the goods basket was accompanied by a weight increase; an error recognition circuit and transmission section (see col 6, line 13 through col. 7, line 9); weight
15 comparison section 42; weight store [38, 39]; output 95 for off-line operation and output S for on-line operation; check-out station 4 (i.e., POS terminal) having a panel/display [4c, 4i]; and a computer 93 which is capable of transmitting/receiving data from the purchasing trolley, and furthermore, the computer 93 includes the means for enabling and/or disabling the trolley via communication means (see col. 19, lines 58+). See figures 1-5, 13, and 23; abstract; col. 1, lines 5-18; col. 1, line 47 through
20 col. 2, line 21; col. 3, line 15 through col. 4, line 63; col. 6, line 13 through col. 7, line 62; col. 14, lines 4-57; col. 16, lines 38-64; and col. 18, line 1 through col. 19, line 38.

In view of Ehrat's teaching, it would have been obvious to an artisan at the time the invention was made to integrate notoriously old and well known scale/weighing equipment and the means for enabling/disabling the trolley to the teachings of Collins for greater security purposes and a more versatile system (i.e., the modified stand-alone system will inherently measure and monitor (i.e., without the aide of a plurality of personnel) when each article is read-in so that fraudulent manipulations are practically eliminated).

Response to Amendment

10. Applicant's arguments filed 30 August 1996 have been fully considered but they are not deemed to be persuasive.

In response to Applicant's argument that "... Collins, Jr. fails to teach a commodity code reading section, ... price retrieval section **fixed** to a transportable accommodation section ..." (See pg. 8, lines 13+), the Examiner respectfully request the Applicants to review the Collins, Jr. (specifically, figure 5 and col. 3, lines 46+) and paragraph 6 above.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

- 5 12. Papers related to this application may be submitted to Group 2500 by facsimile transmission. Papers should be faxed to Group 2500 via the PTO fax machine located in Crystal Plaza 2. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP-2 fax machine number is (703)305-3594 or (703)308-7723.

- 10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Michael G. Lee* whose telephone number is (703)305-3503, and who can be reached between the hours of 6:30AM to 3:00PM Monday thru Thursday and every other Friday (second Friday of the bi-week).

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0956.

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MGL

September 20, 1996


DONALD T. HAJEC
SUPERVISORY PATENT EXAMINER
GROUP 2500